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10/581,581

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Emmanouel Marinos

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EXAMINER

SULLIVAN, DANIELLE D

ART UNIT

PAPER NUMBER

1616

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/581,581	Applicant(s) MARINOS, EMMANOUEL	
	Examiner DANIELLE SULLIVAN	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 June 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>06/02/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-10 are pending examination.

Claim Objections

Claims 3 and 10 are objected to because of the following informalities: 'cationics amphoteric' should be 'cationics, amphoteric'. Appropriate correction is required.

Claim 5 is objected to because of the following informalities: 'washing cleaning' should be 'washing, cleaning'. Appropriate correction is required.

Claim 4 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should only refer to claims in the alternative only. See MPEP § 608.01(n).

Claims 6-9 objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim should only refer to claims in the alternative only. See MPEP § 608.01(n).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claims 1, 5, 9 and 10 recite an improper Markush group, which is not in the alternative. The plants contained in the composition include "urginea maritime or drimia maritime, laurus nobilis, adiantum capillus-veneris, persea americana". The metes and bounds of these claims are unclear because the recitation of the plants can be interpreted in different ways: 1) selected from urginea maritime or drimia maritime and a plant selected from laurus nobilis, adiantum capillus-veneris or persea Americana, 2) selected from urginea maritime, drimia maritime, laurus nobilis, adiantum capillus-veneris or persea americana, or 3) comprising urginea maritime, drimia maritime, laurus nobilis, adiantum capillus-veneris and persea americana. For the purpose of examination the term will be given its broadest reasonable interpretation 2).

The term "pure petroleum appropriate for dermatological use" in claims 2 and 10 is a relative term which renders the claim indefinite. The term "pure" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention. Additionally, petroleum is not to comprising a variety of different components so it is unclear which ingredient is considered to be pure petroleum. The term "pure" and the directed intended use will not be given patentable weight and any petroleum component will be treated as encompassing the subject matter.

Claims 3 and 10 recite "surfactants selected from the groups comprising soap, anionics, nonionics, cationics amphoteric and zwitterionics. Not only is this an improper Markush group which is not in the alternative, but the use of the term "groups comprising" adds indefiniteness, since the term is referring to what the ingredients

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selected from comprise, not what they are. Additionally, it is unclear how soap is classified as a surfactant. Soap is a composition comprising anionic surfactants but not a surfactant.

Claim 10 recites "and or solvents" as being mixed with the composition. The term is indefinite since it is unclear if the solvent is present with the mixture or optionally added to the composition. For the purpose of examination the term will be treated as being optional.

Claims 5-8 provides for the use of the composition, but, since the claim does not set forth any steps involved in the method/process, it is unclear what method/process applicant is intending to encompass. A claim is indefinite where it merely recites a use without any active, positive steps delimiting how this use is actually practiced.

Claims 5-8 is rejected under 35 U.S.C. 101 because the claimed recitation of a use, without setting forth any steps involved in the process, results in an improper definition of a process, i.e., results in a claim which is not a proper process claim under 35 U.S.C. 101. See for example *Ex parte Dunki*, 153 USPQ 678 (Bd.App. 1967) and *Clinical Products, Ltd. v. Brenner*, 255 F. Supp. 131, 149 USPQ 475 (D.D.C. 1966).

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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Claims 7 and 8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant claims processes for decreasing hair loss and regenerating and/or stimulating hair growth using the composition. The specification does not contain reference to a method of decreasing hair loss or regenerating and/or stimulating hair growth nor provide specific method steps.

Claims 5-8 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The invention is directed toward the use of *urginea maritime* and *drimia maritime* for cleaning, treating, reducing hair greasiness, sebum and hair loss.

Attention is directed to *In re Wands*, 8 USPQ2d 1400 (CAFC 1988) at 1404 where the court set forth the eight factors to consider when assessing if a disclosure would have required undue experimentation. Citing *Ex parte Forman*, 230 USPQ 546 (BdApls 1986) at 547 the court recited eight factors:

- 1) the nature of the invention
- 2) the state of the prior art
- 3) the relative skill of those in the art
- 4) the predictability of the art
- 5) the breadth of the claims
- 6) the amount of direction or guidance provided
- 7) the presence or absence of working examples

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8) the quantity of experimentation necessary

The instant specification fails to provide guidance that would allow the skilled artisan to practice the instant invention without resorting to undue experimentation, as discussed in the subsections set forth herein below.

The nature of the invention.

The claimed invention is the use of urguinea maritime and drimia maritime for cosmetic use on hair for cleaning, treating, reducing hair greasiness, sebum and hair loss.

The state of the prior art & predictability of the art

Urginea maritime and drimia maritime (Squills) is known to be used as a rat poisoning as disclosed by Eberhardt (US 1,506,575). When placed into contact with hands (skin) itching occurs (column 1, lines 27-31). Therefore, it is unclear how a known rat poisoning can be safely incorporated into a cosmetic without risk of harm to the health of the skin.

The presence or absence of working examples

The specification does not provide detailed evaluation how the composition comprising urguinea maritime or drimia maritime can safely clean, treat, reduce hair greasiness, sebum and hair loss.

The quantity of experimentation necessary & relative skill in the art

To determine how to prepare a safe cosmetic composition comprising urguinea maritime and drimia maritime would require undue experimentation for one skilled in the art.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4, 9 and 10 are rejected under 35 U.S.C. 102(b) as being anticipated by Eberhardt (1,506,575).

Eberhardt discloses a composition comprising scilla maritime (urginea maritime and drimia maritime). The bulbs are cut in pieces mixed with paraffin oil (petroleum). The paraffin is extracted by mixing with solvents such as ether or chloroform (column 1, lines 9-13, 27-31; column 2, lines 83-88). The composition is used as a rat poisoning (pesticide).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

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the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 3 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eberhardt (US 1,506,575) in view of Hyldgaard et al. (US 6,342,208).

Applicant's Invention

Applicant claims the composition as disclosed above is a pesticide. Claim 3 further adds surfactants that are anionic, nonionic, cationic, amphoteric or zwitterionic. Claims 5-8 further use the composition on hair to clean, reduce greasiness and decrease hair loss.

Determination of the scope and the content of the prior art

(MPEP 2141.01)

The teachings of Eberhardt are addressed in above 102(b) rejection. Eberhardt teaches that dried squill loses its activity during transportation (column 1, lines 25-27).

Ascertainment of the difference between the prior art and the claims

(MPEP 2141.02)

Eberhardt does not teach the use of surfactants or that the composition is used on hair. It is for this reason that Hyldgaard et al. is joined.

Hyldgaard et al. teaches cosmetic composition for cleaning skin and hair useful against parasites such as, lice, fleas, scabies, etc. (pesticide) (column 6, lines 30-35). The composition may contain surfactants that are anionic, nonionic, cationic or amphoteric (column 9, lines 6-12). The surfactants aid in stabilization of the composition (column 9, lines 3-5).

Finding of prima facie obviousness

Rationale and Motivation (MPEP 2142-2143)

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Eberhardt and Hyldgaard et al. to utilize surfactants. One would have been motivated to include surfactants with the composition because Hyldgaard et al. teaches that surfactants stabilize compositions and Eberhardt teaches that dried squill loses its activity during transportation.

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the teachings of Eberhardt and Hyldgaard et al. to utilize the composition for treating hair. One would have been motivated to include a method of treating hair with the composition because Hyldgaard et al. teaches that the composition is pesticidal. It would have been prima facie obvious to combine the two compositions, since Eberhardt teaches they are useful for the same purpose, in order to form a third composition that is to be used for the very same purpose; the idea of combining them flows logically from their having been individually taught in prior art.” In re Kerkhoven 205 USPQ 1069, (C.C.P.A. 1980).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yoshpa (US 2002/0164384).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danielle Sullivan whose telephone number is (571) 270-3285. The examiner can normally be reached on 7:30 AM - 5:00 PM Mon-Thur EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Johann Richter can be reached on (571) 272-0646. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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